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EXAMINER	
LIGHTFOOT, ELENA TSOY	
ART UNIT	PAPER NUMBER
1792	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action

The Request for Reconsideration filed on June 24, 2009 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on April 6, 2009.

Response to Arguments

Applicants' arguments filed June 24, 2009 have been fully considered but they are not persuasive.

A. Rejections of Claims 42-48 over *Nguyen et al, Wang et al* and *Lee et al*

Applicants submit that the combination of Nguyen, Wang, and Lee fails to teach or suggest several elements of independent claim 42, and, for several reasons, there is no teaching, suggestion, or rational explanation for combining various elements from these references to arrive at Applicants' claimed methods.

1. Nguyen does not teach or suggest the use of "any" acid-releasing degradable material.
2. There is no teaching, rational explanation, or reasonable expectation of success to combine or substitute the tackifying compounds of Nguyen and the polyglycolic acids of Lee.
3. Nguyen does not include "allowing the acid-releasing degradable material to produce acid," as recited in claim 42, and there is no teaching or rational explanation for modifying Nguyen to do so.
4. The methods and materials of Lee are incompatible with and teach away from coating a coating solution onto a particulate "on-the-fly," as recited in claim 42.

The Examiner respectfully disagrees with this argument.

As to arguments 1 and 2, as was explained before, Nguyen does not limit their teaching to particular tackifying compounds. At col. 5, lines 10-19, Nguyen teaches: "Compounds suitable for use as a tackifying compound comprise substantially **any** compound which when in liquid form or in a solvent solution will form a non-hardening coating, by themselves"; and at col. 6, lines 9-14 Nguyen teaches: "*Additional* compounds which may be utilized as tackifying compounds include liquids and solutions of, for example, polyesters, polyethers and polycarbamates, polycarbonates, styrene-butadiene latticies, *natural or synthetic resins* such as

shellac and the like". Nguyen teaches that a *preferred* tackifying compound is polyamide (See column 5, lines 21-26). Note that the tackifying compound in Nguyen should subsequently release a treatment chemical from a tackifying compound coating within the subterranean formation, i.e. **should be *degradable* within the subterranean formation**. Thus, in contrast to Applicants statement, col. 5, lines 10-19 and col. 6, lines 9-14 of Nguyen show that ***any*** natural or synthetic resins **capable of subsequently releasing a treatment chemical** may be used as a tackifying compound. Lee teaches that compounds that slowly hydrolyze and release an acidic by-product e.g. lactic polymer (i.e. should be *degradable)* are suitable to be used to degrade a filter cake. It is held that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used lactic polymer as a tackifying compound in Nguyen with the expectation of providing the desired **subsequently releasing a treatment chemical** since Lee teaches that lactic polymer slowly degrades by hydrolyzation within the subterranean formation, and Nguyen does not limit their teaching to particular tackifying compounds.

Moreover, there is also ***further* motivation** to combine Nguyen with Lee to provide both slow release of the biocide or corrosion inhibitor and degrading a filter cake due to acid release.

As to argument 3, one of ordinary skill in the art would have **reasonable expectation of success** of using polylactide of Lee because Nguyen does not limit their teaching to particular tackifying compounds, and, thus, *any* degradable resin may be used as a tackifying compound including degradable polylactide of Lee.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1792

July 1, 2009

/Elena Tsoy Lightfoot/